

REMARKS

I. Introduction

Applicants respectfully thank Examiner Hug for the courtesies extended in the personal interview of January 11, 2007.

Upon entry of the foregoing amendment, claims 1-45 are pending in this application. Claims 1, 23, 32-34, 36, and 37 have been amended and new claims 39-45 have been added. No new matter is being included. In view of the following remarks, Applicants respectfully request the allowance of all the pending claims.

II. Objections to the Specification

The Examiner has objected to the amendment filed September 28, 2006 under 35 USC 132(a) as allegedly introducing new matter.

Applicants have amended independent claims 1, 23, and 32 to clarify the subject matter being claimed, in view of the Examiner's objections. Applicants respectfully submit that the amendments of these claims, as presently recited, do not introduce new matter into the disclosure.

As a practical matter, Applicants respectfully note that the spacer 62 shown in Figure 2 of the specification is capable of abutting the passive door 16. Obviously, this spacer 62 would abut the passive door 16, at some point, in order to perform its spacing function.

Accordingly, it is respectfully requested that these objections to the specification be withdrawn by the Examiner.

III. Claim Rejections under 35 USC 112

Claims 1-38 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants' regard as the invention.

Applicants have amended claims 1 and 32 to clarify the meaning of “therebetween” and “an opposed side,” respectively. In view of these amendments, Applicants respectfully submit that independent claims 1 and 32 particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

IV. Claim Rejections under 35 USC 102

A. Hagemeyer et al., U.S. Patent No. 4,573,287

Claims 1-3, 5-8, 10-17, 22, 32, 35, 36, and 38 have been rejected under 35 USC 102(b) as being anticipated by Hagemeyer et al. (“Hagemeyer”), U.S. Patent No. 4,573,287. Applicants respectfully request reconsideration of these claims for at least the following reasons.

Applicants have amended independent claim 1 to recite, *inter alia*, “a passive door having an interior surface, an exterior surface opposite to the interior surface, and an outer edge extending from the exterior surface to the interior surface” and “a spacer extending outwardly from the side portion ...to maintain an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail ... to allow air flow between the outer edge of the passive door and the side portion of the metallic rail.” Hagemeyer does not disclose these features.

In the Office Action of October 18, 2006, the Examiner relies on Figure 6 of Hagemeyer as allegedly anticipating Applicants’ independent claim 1. Figure 6 of Hagemeyer illustrates an astragal 62 having astragal core 78 and an astragal cladding 79 disposed next to a door (on the right). Specifically, the Examiner interprets the rightmost L-shaped protrusion (not labeled) of the astragal cladding 79 extending toward the outer surface of the door on the right as being the same as Applicants’ “spacer,” as recited in independent claim 1.

However, Applicants respectfully point out that Hagemeyer’s L-shaped protrusion of the astragal cladding 79 does not “extend[ing] outwardly from the side portion ...to

maintain an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail ... to allow air flow between the outer edge of the passive door and the side portion of the metallic rail,” as presently recited in independent claim 1.

Although there appears to be space between a small portion of the outer edge of Hagemeyer’s door and the astragal 62 shown in Figure 6, Hagemeyer’s L-shaped protrusion of the astragal cladding 79 does not “maintain an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail ... to allow air flow between the outer edge of the passive door and the side portion of the metallic rail.” In fact, Hagemeyer’s L-shaped protrusion of the astragal cladding 79 does not even relate to this space between the outer edge of Hagemeyer’s door and the astragal 62.

Furthermore, Hagemeyer’s L-shaped protrusion does not contact or extend toward the outer edge of the door shown on the right in Figure 6 of Hagemeyer. Since the rightmost L-shaped protrusion of the astragal cladding 79 shown in Figure 6 of Hagemeyer does not extend toward, let alone contact the outer edge of Hagemeyer’s door, this rightmost L-shaped protrusion of the astragal cladding 79 shown in Figure 6 of Hagemeyer cannot be interpreted by the Examiner as being the same as “a spacer extending outwardly from the side portion ...to maintain an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail ... to allow air flow between the outer edge of the passive door and the side portion of the metallic rail,” as presently recited in independent claim 1 of Applicants’ invention. As a result, Hagemeyer does not anticipate these features.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the...claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). “The elements must be arranged as required by the claim...” In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Further, in the event that the Office Action is relying on the theory of inherency in any manner, “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the

applied art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See also MPEP 2112.

Accordingly, since Hagemeyer does not explicitly or inherently show every element as presently recited in independent claim 1, Hagemeyer cannot be properly used to reject independent claim 1 under 35 U.S.C. § 102. Therefore, it is respectfully submitted that independent claim 1 is allowable over Hagemeyer, and withdrawal of this rejection is earnestly solicited.

Regarding claims 2-3, 5-8, 10-17 and 22, it is respectfully submitted that for at least the reason that claims 2-3, 5-8, 10-17 and 22 depend from independent claim 1, and therefore contain each of the features as presently recited in this claim, claims 2-3, 5-8, 10-17 and 22 are therefore also patentable over Hagemeyer, and withdrawal of the rejection of these claims is also earnestly solicited.

Independent claim 32 has been amended to recite, *inter alia*, “an insert member retained substantially within a channel in the extruded aluminum rail formed by the exterior portion, the interior portion and the side portion.” Hagemeyer does not disclose these features.

At page 7 of the Office Action of October 18, 2007, the Examiner relies on (1) “the lower most portion of the rail as shown in figure 6” as Applicants’ “exterior portion” of the claimed extruded aluminum rail, (2) “the horizontal portions extending towards each other into the wooden insert 78” as Applicants’ “interior portion” of the claimed extruded aluminum rail, and (3) “the rail connecting the right hand side of the interior portion to the exterior portion” as Applicants’ “side portion” of the claimed extruded aluminum rail. Therefore, the Examiner’s position apparently defines a “channel” as the area between the parts of the astragal cladding 79 being relied on above (see (1), (2), and (3) above) as the “exterior portion,” “interior portion,” and “side portion,” as recited in independent claim 32 of Applicants’ invention.

However, it is evident from Figure 6 in Hagemeyer that the core 78, which the Examiner relies on as the claimed “insert,” is only partially engaged in the cladding 79. Furthermore, the core 78 is clearly not “retained substantially within” the portions of the cladding 79 ((1), (2), and (3)) being relied on by the Examiner to define “a channel.”

In other words, only a small part of the core 78 is disposed in the rail 79 up to the horizontal portions extending toward each other into the core 78 (the Examiner relies on these horizontal portions as the “interior portion” recited in Applicants’ claim 32). Therefore, the astragal core 78 shown in Figure 6 of Hagemeyer cannot be interpreted as “an insert member retained substantially within a channel in the extruded aluminum rail formed by the exterior portion, the interior portion and the side portion,” as presently recited in independent claim 32 of Applicants’ invention. As a result, Hagemeyer fails to disclose all the features recited in independent claim 32.

Accordingly, since Hagemeyer does not explicitly or inherently show every element as presently recited in independent claim 32, Hagemeyer cannot be properly used to reject independent claim 32 under 35 U.S.C. § 102. Therefore, it is respectfully submitted that independent claim 32 is allowable over Hagemeyer, and withdrawal of this rejection is earnestly solicited.

Regarding claims 35, 36, and 38, it is respectfully submitted that for at least the reason that claims 35, 36, and 38 depend from independent claim 32, and therefore contain each of the features as presently recited in this claim, claims 35, 36, and 38 are therefore also patentable over Hagemeyer, and withdrawal of the rejection of these claims is also earnestly solicited.

B. Wendt, U.S. Patent No. 4,281,480

Claims 1 and 18 have been rejected under 35 USC 102(b) as being anticipated by Wendt, U.S. Patent No. 4,281,480. Applicants respectfully request reconsideration of these claims for at least the following reasons.

Independent claim 1 has been amended to recite, *inter alia*, “a metallic rail having an exterior portion, an interior portion spaced from and opposed to the exterior portion, and a side portion extending between the exterior portion and the interior portion and forming an angle with each of the exterior portion and the interior portion, and a spacer extending outwardly from the side portion away from the exterior portion and the interior portion of the metallic rail ...” Wendt does not disclose these features, as recited, in independent claim 1 of Applicants’ invention.

First, Applicants respectfully note that Wendt is directed to a doorframe assembly 21 at a hinge side 16 of a door for attachment on a hollow wall partition. See Wendt, Figure 3, Abstract, and column 4, lines 55-56. As can be seen in Figures 2 and 3 of Wendt, Wendt's doorframe assembly 21 is disposed on the end of wall panels 11 and vertical stud member 19. Therefore, it is evident that Wendt's doorframe assembly 21 is not used on a passive door in the manner recited in Applicants' independent claim 1.

Moreover, since Wendt's doorframe assembly 21 is disposed at the hinge side 16 of the hollow wall panels 11 (and not on a passive door), Wendt cannot possibly disclose "a spacer ... having a distal end to maintain an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail when the astragal assembly is affixed thereto to allow air flow between the outer edge of the passive door and the side portion of the metallic rail," as presently recited in independent claim 1 of Applicants' invention.

Furthermore, in the rejection based on Wendt, the Examiner appears to be relying on a theory that Wendt's doorframe assembly 21 *might* meet the elements of Applicants' claim 1, *if* the doorframe assembly 21 was somehow removed from Wendt's hollow wall panels 11 and placed on an end of a passive door. However, Applicants note that Wendt does not disclose this possibility either explicitly or inherently anywhere in the reference.

Again, Wendt is only directed to a door frame assembly mounted on wall panels at the hinge side of a door. Since Wendt does not disclose any type of astragal assembly for attachment to a passive door, Wendt necessarily fails to disclose "a spacer ... having a distal end to maintain an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail when the astragal assembly is affixed thereto to allow air flow between the outer edge of the passive door and the side portion of the metallic rail," as presently recited in independent claim 1 of Applicants' invention.

Furthermore, at page 4 of the Office Action of October 18, 2007, the Examiner relies on web member 23 shown in Figure 3 of Wendt to allegedly anticipate "a metallic rail," as recited in independent claim 1 of Applicants' invention. More particularly, the Examiner relies on the free leg 25 shown in Figure 3 of Wendt to read as Applicants' claimed "exterior portion" and the free leg 26 shown in Figure 3 of Wendt to read as

Applicants' claimed "interior portion." Finally, the Examiner relies on Wendt's thicker web portion 24 to read as Applicants' claimed "spacer."

However, Applicants respectfully note that the thicker web portion 24 shown in Figure 3 of Wendt does not "extend[ing]...away from" the free leg 25 and the free leg 26. In contrast with the present invention, it is evident from Figure 3 that Wendt's thicker web portion 24, being relied on by the Examiner as "a spacer," extends toward the free leg 25 and does not extend away from the free leg 26. Since the thicker web portion 24 does not extend away from the free leg 25 and the free leg 26 shown in Figure 3 of Wendt, the thicker web portion 24 cannot be interpreted as meeting Applicants' "a spacer extending outwardly from the side portion away from the exterior portion and the interior portion of the metallic rail," as presently recited in independent claim 1. As a result, Wendt's door frame assembly 21 does not anticipate independent claim 1 of Applicants' invention, as presently recited.

Accordingly, since Wendt does not explicitly or inherently show every element as presently recited in independent claim 1, Wendt cannot be properly used to reject independent claim 1 under 35 U.S.C. § 102. Therefore, it is respectfully submitted that independent claim 1 is allowable over Wendt, and withdrawal of this rejection is earnestly solicited.

Regarding claim 18, it is respectfully submitted that for at least the reason that claim 18 depends from independent claim 1, and therefore contains each of the features as presently recited in this claim, claim 18 is therefore also patentable over Wendt, and withdrawal of the rejection of this claim is also earnestly solicited.

C. Procton, U.S. Patent No. 5,335,450

Claims 23, 25-29, and 31 have been rejected under 35 USC 102(b) as being anticipated by Procton, U.S. Patent No. 5,335,450. Applicants respectfully request reconsideration of these claims for at least the following reasons.

Here, Applicants simply point out that Procton fails to disclose, among other things, "a passive door having an interior surface, an exterior surface opposite to the interior surface, and an outer edge extending from the exterior surface to the interior surface" and "a spacer extending outwardly from the side portion ...and having a distal

end that maintains an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail to allow air flow between the outer edge of the passive door and the side portion of the metallic rail,” as presently recited in independent claim 23 of Applicants’ invention.

In fact, there is no “air gap” between an outer edge of Procton’s fixed door 11 and any other component shown in Figure 2 of Procton. Rather, an entire surface of the outer edge of Procton’s fixed door 11 abuts against the wooden interior portion 16 and the extruded exterior portion 15. *See* Procton, Figure 2. As a result, Procton fails to disclose, among other things, “a spacer extending outwardly from the side portion ...and having a distal end that maintains an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail to allow air flow between the outer edge of the passive door and the side portion of the metallic rail,” as presently recited in independent claim 23 of Applicants’ invention.

Moreover, the part of the exterior aluminum portion 15 extending to a front side of the fixed door 11 shown in Figure 2 of Procton cannot be interpreted as “a spacer ... that maintains an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail.” As a result, Procton fails to disclose each of the features of independent claim 23 of Applicants’ invention, as presently recited.

Accordingly, since Procton does not explicitly or inherently show every element as presently recited in independent claim 23, Procton cannot be properly used to reject independent claim 23 under 35 U.S.C. § 102. Therefore, it is respectfully submitted that independent claim 23 is allowable over Procton, and withdrawal of this rejection is earnestly solicited.

Regarding claims 25-29 and 31, it is respectfully submitted that for at least the reason that claims 25-29 and 31 depend from independent claim 23, and therefore contain each of the features as presently recited in this claim, claims 25-29 and 31 are therefore also patentable over Procton, and withdrawal of the rejection of these claims are also earnestly solicited.

V. Claim Rejections under 35 USC 103

Claims 4, 9, 19-21, 24, 30, 33, 34, and 37 have been rejected in view of various hypothetical combinations of secondary patent references with Procton or Hagemeyer, as previously applied against independent claims 1, 23, and 32. However, Applicants respectfully submit that even if these various combinations are assumed to be proper, the references being relied on by the Examiner, either alone or in combination with one another, fail to disclose, teach, or suggest all the features of independent claims 1, 23, and 32, as discussed above.

More specifically, none of the references cited on the record disclose, teach, or suggest (1) “a metallic rail having an exterior portion, an interior portion spaced from and opposed to the exterior portion, and a side portion extending between the exterior portion and the interior portion and forming an angle with each of the exterior portion and the interior portion, and a spacer extending outwardly from the side portion away from the exterior portion and the interior portion of the metallic rail and having a distal end to maintain an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail when the astragal assembly is affixed thereto to allow air flow between the outer edge of the passive door and the side portion of the metallic rail...,” as presently recited in independent claim 1 of Applicants’ invention; (2) “a passive door having an interior surface, an exterior surface opposite to the interior surface, and an outer edge extending from the exterior surface to the interior surface...” and “... a metallic rail having an exterior portion, an interior portion spaced from and opposed to the exterior portion, and a side portion that extends between the exterior portion and the interior portion, and a spacer extending outwardly from the side portion away from the exterior portion and the interior portion of the metallic rail and having a distal end that maintains an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail to allow air flow between the outer edge of the passive door and the side portion of the metallic rail...” as presently recited in independent claim 23 of Applicants’ invention; and (3) “an insert member retained substantially within a channel in the extruded aluminum rail formed by the exterior portion, the interior portion and the side portion...” as presently recited in independent claim 32 of Applicants’ invention.

Since all of the features of independent claims 1, 23, and 32 are not taught or suggested by the references cited by the Examiner, these claims are patentable over the references on the record. Accordingly, dependent claims 4, 9, 19-21, 24, 30, 33, 34, and 37 are also patentable over the references of record, at least, by virtue of their dependency on one of the patentable independent claims.

VI. New Claims

New claims 39-45 have been added to the application. New dependent claim 39 further defines features presently recited in independent claim 1. New independent claim 40 provides an alternate recitation of the present invention, as recited in independent claim 1. New dependent claim 41 further defines the features recited in independent claim 40. New independent claim 42 also provides an alternate recitation of the present invention, as recited in independent claim 1. New dependent claims 43-45 further define features recited in independent claim 42. Applicants submit that new claims 39-45 are clearly supported by Figure 2 of the specification and the corresponding portion(s) of the detailed description.

It is respectfully submitted by Applicants that new claims 39-45 are allowable over all the references cited on the record. Accordingly, Applicants respectfully request that the Examiner allow these claims.

VII. Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

A fee of \$750 for additional claims has been incurred by this Amendment. If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account debit Account 50-0548.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Valencia', written over a horizontal line.

Daniel E. Valencia
Registration No. 56,463
Attorney for Applicant

Berenato, White & Stavish LLC
6550 Rock Spring Drive, Ste. 240
Bethesda, Maryland 20817
(301)896-0600